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Application No. 9/386,775

Docket No.: 00-VE13.51

REMARKS

The Office Action dated December 19, 2006 has been carefully reviewed and the following remarks are made in consequence thereof. Claims 1-7 and 11-21 are pending. Claims 8-10 were objected to and are now cancelled. Claims 19-21 are new. The Examiner rejected claims 1-3, 6-7, 11-15 and 17-18 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Applicants' Admitted Prior Art ("AAPA") in view of U.S. Patent No. 5,550,901 to Williams ("Williams"). The Examiner further rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being allegedly unpatentable over AAPA in view of Williams, and in further view of U.S. Patent No. 5,255,267 to Hansen et al. ("Hansen"). Claim 16 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over AAPA in view of Hansen. Applicants respectfully request reconsideration of the pending claims in view of the following remarks.

Allowable Subject Matter

Claims 8-10 were objected to by the Examiner. (Office Action, Page 5). Applicants thank the Examiner for indicating claims 8-10 as being allowable if rewritten in independent form. Applicants have added new claims 19-21 which correspond to canceled claims 8-10 if they had been rewritten in independent form including all limitations of the base claim and any intervening claims per the Examiner's suggestion. Accordingly claims 19-21 are allowable.

Claim Rejections Under 35 USC §103(a)**I. The Law**

The basic requirements for the Patent and Trademark Office to meet its burden of establishing *prima facie* obviousness are as follows:

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

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Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), *W.L. Gore and Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (Fed. Cir. 1966).

Further, as the Federal Circuit has stated, “[i]f identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.” *In re Rouffet*, 47 USPQ2d 1453 at 1457 (Fed. Cir. 1998). “Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’” *Id.* (quoting *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996)). Indeed, “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

II. Claims 1-3, 6-7, 11-15 and 17-18

Claims 1-3, 6-7, 11-15 and 17-18 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over AAPA in view of Williams.

a. Claim 1

Claim 1 recites in part:

placing a local loop generation mechanism in series with a communications path between the central office and the customer;

placing a frequency-selective filter in parallel with the local loop generation mechanism to provide a bypass path across the local loop generation mechanism. (Emphasis added).

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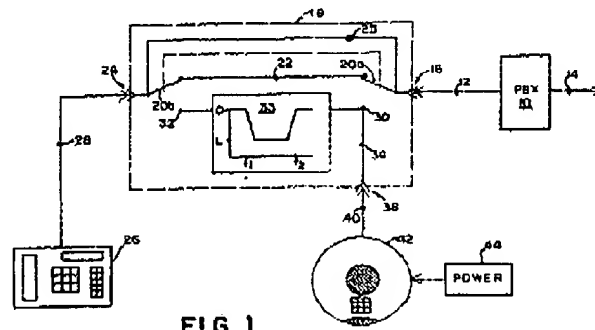
The Examiner conceded that AAPA fails to teach "placing a frequency-selective filter in parallel with the local loop generation mechanism," as recited by claim 1. (Office Action, Page 3). The Examiner relies upon Williams alone to allegedly teach this feature. However, Williams does not cure the deficiency of AAPA.

The Examiner stated that Williams allegedly shows:

The band-reject filter 33 is a passive LC network and capacitor C6, as shown in figure 2, [is] connected in parallel with the links 22 and 25 as shown in figure 1. (Emphasis added; Office Action, Page 3).

Applicants respectfully disagree. Indeed, band-reject filter 33 is in series with the TIP conductor when switches 20a, 20b (as shown in Figures 1 and 2) are switched to contacts 30 and 32. Figure 1 shows filter 33 as being in series with terminals 16 and 24. Jumpers 25 are not actually connected to switches 20a, 20b as Figure 1 may erroneously suggest, but rather are meant to show that other wires also connect straight-through adapter 18:

Other conductors, if any, within line 28 from the PBX telephone 26, are connected directly through adapter 18 with corresponding conductors of line 12 via jumpers 25. In that manner, connection between those other conductors is maintained regardless of the position of switches 20a and 20b. (Williams, Col. 4, Lines 16-18; Figure 1).



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In detail, Figure 2 shows that when switches 20a and 20b are in the "normal" position, there is a direct TIP connection along conductor 22 (as shown in Figure 2). (Williams, Col. 5, Lines 52-57). When switches 20a and 20b are in the "conference" position, band-reject filter 33 is connected in series between terminals 16 and 24 (shown in Figure 1) of the TIP circuit. (Williams, Col. 5, Lines 58-63). As shown in Figure 2, the connection of tip terminal 4 (shown on the left) and tip terminal 3 (shown on the right) is only accomplished by passing current through the filter. Thus, band-reject filter 33 is in series with the TIP circuit. Indeed, band-reject filter 33 must be in series because there would otherwise be no circuit path through TIP terminal 4 (shown on the left in Figure 2) and TIP terminal 3 (shown on the right in Figure 2).

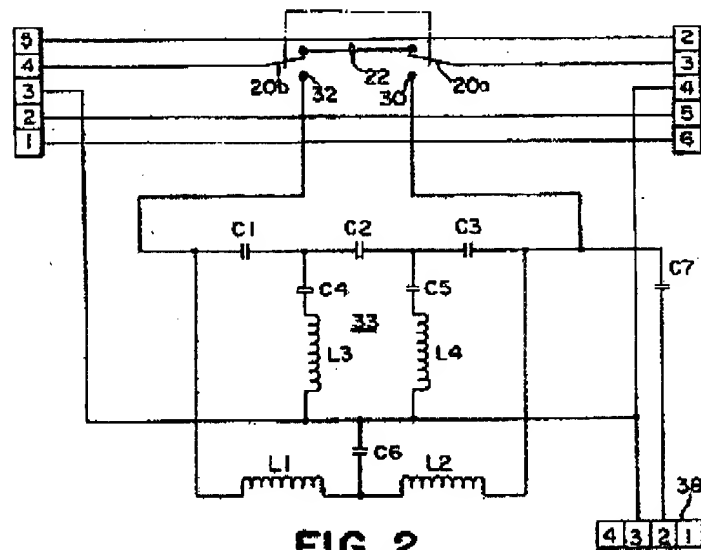


FIG. 2

Additionally, the Examiner points to a section of Williams that discusses band-reject filter 33 (Office Action, Page 6) where:

[T]he band-reject filter 33 is connected between the tip and ring conductors of the PBX telephone 26 and the corresponding conductors of signal line 12 leading to the exchange 10. (Williams, Col. 4, Lines 11-15).

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This statement of Williams is clarified by a review of Figure 2 in that band-reject filter 33 is in series with the TIP connections. The “between” statement of Williams does not indicate a parallel relationship between them, and as discussed above, the TIP line is in series with filter 33. The RING line merely provides a ground for filter 33. Moreover, the series nature of filter 33 is evidenced by switches 20a, 20b (as shown in Figures 1 and 2) that are switched to contacts 30 and 32 such that filter 33 is connected in series with the TIP circuit (also discussed above).

Additionally, the Examiner apparently contradicts his own allegations in the response to arguments by conceding that the band-reject filter 33 is in series with the local loop generation mechanism (rather than “in parallel with the local loop generation mechanism” as recited by claim 1) by stating that:

[I]t is clearly understood that the band reject filter 33 is connected in *series* between the PBX telephone 26 and the exchange 10. (Emphasis in original; Office Action, Page 6).

Thus, the Examiner agrees with Applicants that band-reject filter 33 is in series with PBX telephone 26 and exchange 10.

In sum, Williams shows a filter 33 in series with a local loop, the local loop being shown between PBX telephone 26 and telephone 42. (Williams; FIG. 1; Col. 4, Lines 11-15). Therefore, the series filter of Williams does not disclose “in parallel with the local loop,” as claim 1 recites. Thus, Williams does not meet the burden of a prima facie case requiring all elements. For at least this reason, claim 1 is allowable over the cited prior art.

b. Claims 2-3, 6-7, 11-15 and 17-18

Independent claims 2 and 17-18 all recite a frequency-selective filter placed in parallel with a local loop generation mechanism. As set forth above, neither AAPA nor Williams discloses the parallel claim element. Therefore, claims 2, 17 and 18 are allowable over the cited prior art. Moreover, claims 3, 6-7, and 11-15 depend from claim 2. Thus, for at least the same reasons as claim 2, claims 3, 6-7, and 11-15 are allowable over the cited prior art.

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Additionally, the dependent claims also contain independently patentable elements. For example, claim 3 recites "wherein the frequency selective filter is adapted to pass at least those frequencies which carry digital information." Claim 11 recites "wherein the communications path is adapted to convey digital signals and voice information." Claim 13 recites "wherein the baseband signal occupies a first portion of the electromagnetic spectrum and the data signals occupy a second portion of the electromagnetic spectrum." Claim 14 recites "wherein baseband signals are limited to an approximate frequency range of about 20 Hz to about 3.3KHz, and digital signals are allowed to occupy frequencies above about 20 KHz." Claim 15 recites "wherein the frequency selective filter is provided in the form of a high-pass and/or bandpass filter." However, neither AAPA nor Williams discloses the claim recitations above. Thus, at least because the Examiner's cited prior art does not disclose all elements, claims 3, 6-7, and 11-15 are allowable over the cited prior art.

III. Claims 4 and 5

Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over AAPA in view of Williams, and in further view of Hansen.

a. Claim 4

Claim 4 recites in part:

wherein the frequency selective filter is a high-pass filter. (Emphasis added).

Williams teaches a band-reject filter 33. (Williams; FIG. 1; Col. 4, Lines 21-31). A band-reject filter is not a "high-pass filter," as claim 4 recites. Moreover, Hansen discusses a high-pass filter only in combination with a low-pass filter to pass broadband and baseband data signals. (Hansen, Col. 3, Lines 29-33). Moreover, Hansen does not discuss or even contemplate a "central office" or a "local loop generation mechanism". Hansen discusses extending an Ethernet network. (Hansen, Col. 1, Lines 21-31). Such a system is contrary to and not combinable with local loop and central office systems. Thus, there is no motivation to combine Hansen with Williams. Moreover, there is no reasonable expectation of success in an attempted

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combination. Additionally, even though Hansen discusses a high-pass filter, the filter does not meet the recited claim element because the structure of the independent claim, and intervening claim, is not disclosed. Thus, claim 4 is in condition for allowance over the cited prior art.

b. Claim 5

Claim 5 recites in part:

wherein the frequency selective filter is a bandpass filter. (Emphasis added).

Williams teaches a band-reject filter 33. (Williams; FIG. 1; Col. 4, Lines 21-31). A band-reject filter is not a "bandpass filter," as claim 5 recites. Moreover, the Examiner alleged that Hansen discloses a "bandpass filter." However, a bandpass filter is not disclosed in Hansen. Thus, the combination of AAPA, Williams, and Hansen does not disclose all elements of the claim. Thus, the 35 U.S.C. §103(a) rejection of claim 5 should be withdrawn and the claim allowed over the cited prior art.

IV. Claim 16

Claim 16 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over AAPA in view of Hansen.

Claim 16 recites in part:

providing a communications path communicating information over at least two frequency ranges concurrently, wherein the at least two frequency ranges are defined by a first frequency range and a second frequency range, the second frequency range being generated by a local loop; and

placing a frequency selective filter in parallel with the communications path to provide for the interruption of the communications on the first frequency range while maintaining communications on the second frequency range.
(Emphasis added).

Hansen discusses extending an Ethernet network. (Hansen, Col. 1, Lines 21-31). Hansen does not disclose or even contemplate a "local loop". Moreover, neither AAPA nor Hansen

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disclose “to provide for the interruption of the communications on the first frequency range while maintaining communications on the second frequency range”, as recited by claim 16. (Emphasis added). Hansen teaches connecting systems to an Ethernet network and does not “provide for the interruption of the communications” in any way. As discussed above, Hansen’s system is contrary to and not combinable with local loop systems. Thus, there is no motivation to combine Hansen with AAPA. Moreover, there is no reasonable expectation of success in an attempted combination. Additionally, even though Hansen discusses filters, at least the above emphasized claim recitations are not shown in Hansen. For at least these reasons, claim 16 is in condition for allowance over the cited prior art.

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CONCLUSION

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under order number 65632-0129. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

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